



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/788,443      | 02/21/2001  | Yoshiyuki Suda       | 018842.1163         | 5233             |

24735 7590 12/11/2002

BAKER BOTTS LLP  
C/O INTELLECTUAL PROPERTY DEPARTMENT  
THE WARNER, SUITE 1300  
1299 PENNSYLVANIA AVE, NW  
WASHINGTON, DC 20004-2400

EXAMINER

DONOVAN, LINCOLN D

ART UNIT PAPER NUMBER

2832

DATE MAILED: 12/11/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/788,443

Applicant(s)

Suda

Examiner

Lincoln Donovan

Art Unit

2832

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Oct 15, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) 3 and 5-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, and 4 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some\* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 14, 12
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 2832

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-2 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, applicant should clarify the connector portion projection and its relationship to the surface of the ring member. The structure of the “closed end surface” and “at least one portion of the ring member forms a bottom of said opening” is unclear.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 and 4, as best able to be understood in view of the rejections under 35 U.S.C. 112, second paragraph, are rejected under 35 U.S.C. 102(b) as being anticipated by applicant's admitted prior art of figures 1-6 (AAPA, hereinafter).

AAPA discloses an electromagnet assembly [figures 1-6] comprising:

Art Unit: 2832

- a ring member [1] formed of a tubular spool with a pair of annular flanges;
- a coil member [3];
- a ring case [4] having an annular groove with an open edge of which is in a direction parallel to its axis in which the coil member is disposed and a closed end surface [figure 4];
- an opening [4a] formed through the ring case adjacent to a closed end surface thereof; and
- a connector [5], connecting an external wire [6a, 6b] to the coil, mounted within and engaging the opening.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 2, as best able to be understood in view of the rejections under 35 U.S.C. 112, second paragraph, is rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA in view of Ishimaru.

AAPA disclose the instant claimed invention except for: the connector being pressed into an opening of a magnet support member.

Ishimaru discloses a connector being pressing into an opening of a magnet support member.

Art Unit: 2832

It would have been obvious to one having ordinary skill in the art at the time the invention was made to press the member of AAPA into the opening, as suggested by Ishimaru, for the purpose of securing the member in place.

### ***Response to Arguments***

7. Applicant's arguments filed 10-15-02 have been fully considered but they are not persuasive.

In regards to the rejection under 35 USC 112, paragraph 2, applicant argues that the structure intended by "a ring case 4 having a closed end surface and an opening formed thereby. The structure shown in the figures and described and claimed does not appear to correspond. Should the opening be closed, it is not clear how it forms an opening. The opening shown appears to be in the side and not the bottom of the ring case. The opening itself does not have a bottom, but rather side perimeter portions.

In regards to the rejection under 35 USC 102, Applicant argues that the "end of the projection portion engages the portion of the ring member which forms the bottom of the opening. See e.g. Fig. 8" is not shown by the prior art. As best able to be understood, in view of applicant's amended claim, the end portion of the projection of the prior art, engages the portion of the ring member that forms the bottom of the opening, see figure 4. Applicant has not clearly claimed any structure to differentiate what is disclosed by the prior art from that of the invention as claimed.

### ***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lincoln Donovan whose telephone number is (703) 308-3111.

Application/Control Number: 09/788,443

Page 5

Art Unit: 2832

The fax number for this Group is (703)-872-9318.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0956.

LDD

December 9, 2002

28  
LINCOLN D. GIOVAN  
PRIMARY EXAMINER  
GROUP 2100